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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,213	10/12/2005	Oliver Feilen	8369.005.US0200	5534
77407 7590 01/09/2009 Novak Druce & Quigg LLP 1300 I Street NW Suite 1000 West Tower Washington, DC 20005				
EXAMINER				
CHAL LONGBIT				
ART UNIT		PAPER NUMBER		
2431				
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01/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/525,213

Applicant(s)

FEILEN ET AL.

Examiner

LONGBIT CHAI

Art Unit

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Currently pending claims are 12 – 18.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/16/2008 has been entered.

Claim Objections

3. Claims 12 and 18 are objected to because of the following informalities: (a) "at least one memory module" and (b) "said memory modules" (Line 2) should be replaced with (a) "at least one memory module(s)" and (b) "said memory module(s)". Appropriate correction(s) is (are) required. Any other claims not addressed are objected by virtue of their dependency should also be corrected.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12 and 18 are indefinite because the claim language "similar identifiers" is not clear regarding what exactly to constitute the degree of the similarity and thereby rendering the

scope of the claim(s) unascertainable. Any other claims not addressed (are objected) by virtue of their dependency should also be corrected.

The following is a quotation of the ***first*** paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 12 and 18 are rejected under 35 U.S.C. 112, first paragraph, Examiner notes the new matter of **"comparing the stored identifier of the read-only memory with the stored identifier of the microcomputer upon seeking access to the stored data of the read-only memory and generating a key for decrypting said encrypted data upon detection of similar identifiers"**, which was added into the claim limitation in the 2nd-RCE amendment filed on 11/26/2008 as failing to comply with the written description requirement. The claims contain subject matters which were not described in the specification – Examiner notes the specification has nowhere ***specifically*** indicating (a) "generating a key for decrypting said encrypted data" *needs to be conditionally depending upon* "detection of similar identifier" and (b) "seeking access to the stored data of the read-only memory" *requires first* "comparing the stored identifier of the read-only memory with the stored identifier of the microcomputer" – Examiner notes, according to the disclosure of instant specification, (1) if the conversely one of the modules has been replaced, the key generated by the microcomputer for decryption does not agree with the encryption and the stored data (*automatically*) can not be correctly accessed (SPEC: Page 4 / 3rd Para) and (2) if one of the extracted IDs does not agree with one of the original IDs, the control device is prevented from operating or the change is diagnosed / displayed (SPEC: Page 5 / 4th Para) – **Examiner notes** there is no such ***redundant*** sequence, being disclosed in the instant specification, as *compare* and then *generate*, as recited in the claim.

6. Furthermore, Claims 12 and 18 are rejected under 35 U.S.C. 112, first paragraph, Examiner notes the new matter of “reading out data (besides identifier) stored in said read-only memory and then encrypting said data utilizing said key and subsequently storing said encrypted data in said read-only memory”, which was added into the claim limitation in the 2nd-RCE amendment filed on 11/26/2008 as failing to comply with the written description requirement. The claims contain subject matters which were not described in the specification – Examiner notes the specification has nowhere **specifically** indicating that the data is first stored in the read-only memory and then get read out to be encrypted and subsequently stored back to the read-only memory – Examiner notes, according to the disclosure of instant specification, the read-only memory stores data which have been encrypted by an encryption process (SPEC: Page 2 / 3rd Para: i.e. read-only memory stores encrypted data) – **Examiner notes** there is no such cumbersome sequence, being disclosed in the instant specification, as *read-out, encrypt and written-back*, as recited in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that forms the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 12 – 15 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Dabbish et al. (U.S. Patent 7,137,001).

As per claim 12 and 18, Dabbish teaches a method for protecting against manipulation of a motor vehicle controller including a microcomputer and at least one memory module, at least one of said memory modules constituting a read-only memory (Dabbish: Figure 1 – 4 and Column 3 Line 36 – 44), comprising:

reading out data stored in said read-only memory (Dabbish: Column 5 Line 46 – 55);

reading out an identifier of said read-only memory (Dabbish: Column 5 Line 20 – 22 / Line 50 – 53);

storing said identifier in said microcomputer (Dabbish: Column 7 Line 65 – Column 8 Line 1 and Column 7 Line 58 – 59: the read-out identifier must be somehow stored either in a register or a temporary memory of the microcomputer first before its CPU processor can compare the identifier against the one from the certification which may be provided as data stored on the internal component (Column 7 Line 58 – 59) according to the basic operations for a microcomputer);

generating a key corresponding to said identifier (Dabbish: Column 7 Line 65 – Column 8 Line 1, Column 7 Line 58 – 59 and Column 8 Line 31 – 34: the certification, which may be provided as data stored on the internal component, certifies that a component having an correct identifier is associated with a key – i.e. generating a key corresponding to said identifier);

encrypting said data utilizing said key (Dabbish: Column 5 Line 3 – 6):

storing said encrypted data in said read-only memory (Dabbish: Column 5 Line 9 – 12 and Column 6 Line 13 – 17);

comparing the stored identifier of the read-only memory with the stored identifier of the microcomputer upon seeking access to the stored data of the read-only memory (Dabbish: Column 7 Line 29 – 35, Column 5 Line 20 – 22 / Line 50 – 53, Column 7 Line 65 – Column 8 Line 1 and Column 8 Line 54 – 57);

generating a key for decrypting said encrypted data upon detection of similar identifiers (Dabbish: Column 5 Line 20 – 22 / Line 50 – 53, Column 7 Line 65 – Column 8 Line 1 and Column 8 Line 54 – 57).

As per claim 13, Dabbish teaches the identifier comprises the identifier of microcomputer (Dabbish: Column 5 Line 20 – 22 / Line 50 – 53).

As per claim 14, Dabbish teaches the identifier comprises the identifier of an additional memory module of the microcomputer (Dabbish: Column 5 Line 50 – 53: a component indeed includes any of memory modules).

As per claim 15, Dabbish teaches said key is stored in the RAM of said computer (Dabbish: Column 8 Line 10 – 17).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabbish et al. (U.S. Patent 7,137,001), in view of Collins et al. (U.S. Patent 7,055,029).

As per claim 17, Dabbish does not disclose expressly regenerating a key for decryption of the data stored encrypted in the reversible read-only memory upon subsequent start-up of the controller.

Collins teaches regenerating a key for decryption of the data stored encrypted in the reversible read-only memory upon subsequent start-up of the controller (Collins : Column 10 Line 12 – 17 and Column 7 Line 12 – 18, Column 8 Line 21 – 24: a reversible read-only memory, according to SPEC, is a ROM that stores encrypted data).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Collins within the system of Dabbish because (a) Dabbish teaches providing a secured mechanism for the vehicle manufacturer to assure that a counterfeit part / component is not later installed in the vehicle which is based upon whether the cryptographic key is successfully utilized (Dabbish: Column 4 Line 1 – 2 and Column 4 Line 11 – 14), and (b) Collins teaches an effective security mechanism to coordinate multiple component / memory cards by generating an unique key from a set of unique seeds stored on each individual of multiple memory cards so that attacking the seeds requires attack on all multiple memory cards (Collins : Column 7 Line 12 – 18, Column 8 Line 21 – 24 and Column 10 Line 13 – 17).

As per claim 16, Dabbish teaches reading out at least part of said identifier of at least one of the modules of the control device to generate a key (Dabbish: Column 7 Line 29 – 35, Column 5 Line 20 – 22 / Line 50 – 53, Column 7 Line 65 – Column 8 Line 1 and Column 8 Line 54 – 57). However, Dabbish does not disclose expressly encryption of data on a reversible read-only memory from a read-protected area of the microcomputer.

Collins teaches Dabbish encryption of data on a reversible read-only memory from a read-protected area of the microcomputer (Collins : Column 7 Line 12 – 18, Column 8 Line 21 – 24 and Column 10 Line 13 – 17). See the same rationale of combination applied herein as above in rejecting the claim 17.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LONGBIT CHAI whose telephone number is (571)272-3788. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Longbit Chai/
Primary Examiner, Art Unit 2431